

### **DETAILED ACTION**

This Action is in response to the communication filed on 1/14/2008.

The amendment filed 1/14/2008 is acknowledged and has been entered.

Claim 81 is currently pending in the application and is addressed herein.

#### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 1/18/08 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

3. Claim 81 is rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

It is noted the MPEP 2137 indicates that where it can be shown that an applicant "derived" an invention from another, a rejection under **35 U.S.C. 102(f)** is proper. *Ex parte Kusko*, 215 USPQ 972, 974 (Bd. App. 1981) ("most, if not all, determinations under section 102(f) involve the question of whether one party derived an invention from another"); and, while derivation will bar the issuance of a patent to the deriver, a disclosure by the deriver, absent a bar

under 35 U.S.C. 102(b), will not bar the issuance of a patent to the party from which the subject matter was derived. *In re Costello*, 717 F.2d 1346, 1349, 219 USPQ 389, 390-91 (Fed. Cir. 1983).

In the instant case, upon updating the search of the instant claim, it was discovered that U.S. Patent No. 7,329,649 (hereafter, “the ‘649 patent”), which claims a viral vector that encodes and expresses MDA-7 (SEQ ID NO:2) and an antisense *ras* nucleic acid, has two inventors (Fisher and Su); it is noted that Su was added as an inventor to the ‘649 patent in a Rule 48 request filed 5/24/2007.

The instant claim is drawn to a method that comprises administering a viral vector that encodes and expresses MDA-7 (SEQ ID NO:2) and an antisense *K-ras* nucleic acid to a subject. The instant case has only one inventor: Paul Fisher, who is also one of the inventors of the ‘649 patent. Since the instant claim is a method that comprises administering a viral vector that encodes and expresses MDA-7 (SEQ ID NO:2) and an antisense *K-ras* nucleic acid to a subject, and the ‘649 patent discloses the viral vector used in the instant method (e.g., see claim 1 and Figure 4), the instant method must have been derived from another, specifically, Fisher and Su as evidenced by the disclosure of the ‘649 patent. It is noted that properly adding Su as an inventor of the instant case would obviate this rejection.

#### ***Response to Arguments***

4. Applicant’s arguments filed 1/14/08, with respect to the rejection(s) of claim(s) under 35 USC 112, first paragraph have been fully considered and are persuasive, in view of the amendment to the claim. Therefore, the rejection has been withdrawn. However, upon further

Art Unit: 1635

consideration, a new ground(s) of rejection is made in view of 35 USC 102(f) for the reasons indicated herein.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. E. Angell whose telephone number is 571-272-0756. The examiner can normally be reached on Monday-Thursday 8:00 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Douglas Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. E. Angell/  
Primary Examiner, Art Unit 1635